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ALSTON & BIRD, LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER LOFTIS, JOHNNA RONEE	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID G. BESHORE

Appeal 2009-009420
Application 09/848,519
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

David G. Beshore (Appellant) seeks our review under 35 U.S.C. § 134 (2010) of the final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2010).

SUMMARY OF DECISION

We REVERSE and enter a new ground of rejection pursuant to 37 C.F.R. 41.50(b).²

THE INVENTION

This invention is a method “for assessing the capability of a process of an organization using a capability maturity model.” Specification 1:10-12.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for assessing a process of an organization comprising:
 - acquiring information concerning the organization and the process;
 - developing a plurality of preliminary findings based upon the information, developing the plurality of preliminary findings including characterizing and labeling each preliminary finding with an associated characterization selected from a group consisting of a strength and a weakness;

² Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Sep. 14, 2007) and Reply Brief (“Reply Br.,” filed Feb. 13, 2009), and the Examiner’s Answer (“Answer,” mailed Dec. 16, 2008).

voting for a conclusion associated with each preliminary finding, wherein said voting occurs electronically, and wherein the conclusion associated with each preliminary finding is selected from a group consisting of an agreement with the preliminary finding and a disagreement with the preliminary finding; and

developing a plurality of final findings, developing the plurality of final findings including characterizing and labeling each final finding with an associated characterization selected from the group consisting of a strength and a weakness, wherein the plurality of final findings are based upon said voting for the conclusion associated with each preliminary finding.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Susan Wilkinson & Melissa Cefkin, Impact of Human Genome Initiative on Society: A Women's Study Approach, <http://web.archive.org/web/19990202130042/http://www-unix.oit.umass.edu/~fholmes/evaluation>. [Hereinafter, Wilkinson.]

The Examiner took official notice that “it is old and well known in the art of survey and evaluation to collect responses in several method[s] including electronic form.” Answer 7 and 11. [Hereinafter, Official Notice I.]

The Examiner took official notice “that since each finding in [Wilkinson] is written in such a way so as to include an inherent characterization, i.e., “suggested reading[s] were *useful* in accomplishing

workshop goals” inherently conveys a strength, it would have been obvious to one of ordinary skill in the art to actually label the findings.” Answer 7, 9, and 11. [Hereinafter, Official Notice II.]

The Examiner took official notice that “it is old and well known to evaluate information collected and determine if more information is needed.” Answer 8 and 12. [Hereinafter, Official Notice III.]

The Examiner took official notice that “it is old and well known for a participant to fill out survey responses without identifying himself.” Answer 8 and 12. [Hereinafter, Official Notice IV.]

The following rejections are before us for review:

1. Claims 1-6 and 15-20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject.
2. Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilkinson and Official Notice I-IV.

ISSUES

The first issue is whether claims 1-6 and 15-20 are directed to non-statutory subject matter under 35 U.S.C. § 101. Specifically, the issue is whether claims 1-6 and 15-20 are directed to an abstract idea.

The second issue is whether claims 1-20 are unpatentable under 35 U.S.C. § 103(a) over Wilkinson and Official Notice I-IV. Specifically, the issue is whether Wilkinson inherently describes acts of characterizing preliminary and final findings as a strength or weakness.

FINDINGS OF FACT

We find that the following enumerated finding of fact (FF) is supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Wilkinson's Table 3 is reproduced below.

TABLE 3. Pre-Workshop Results on Attitudes about Organizing Principles

PRINCIPLE	Strongly Agree	Agree	Not Sure	Disagree	Strongly Disagree
1. Suggested readings for the Workshop are relevant.	48% n=23	37% n=18	13% n=6	--	2% n=1
2. Suggested readings are useful in accomplishing Workshop goals.	34% n=16	38% n=18	27% n=13	--	--
3. This Workshop has been organized according to feminist principles.	25% n=12	49% n=23	25% n=12	--	--
4. This Workshop has been organized according to participatory principles.	36% n=17	40% n=18	25% n=12	--	--
5. As a result of the above, I expect the interactions and experiences to be different than other meetings.	38% n=18	31% n=15	31% n=15	--	--
6. Communication in advance of the Workshop has been effective.	33% n=16	53% n=26	10% n=5	4% n=2	--
7. The physical setting and facilities will be important to the success of the Workshop.	6% n=3	46% n=23	37% n=18	6% n=3	6% n=3

Wilkinson's Table 3 depicts pre-workshop results on attitudes about organizing principles.

ANALYSIS

The rejection of claims 1-6 and 15-20 under §101 as being direct to non-statutory subject matter

In the Answer, the Examiner rejects claims 1-6 and 15-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Answer 5. The Appellant responds that the Examiner failed to establish a prima facie case that claims 1-6 and 15-20 are non-statutory. Reply Br. 2-3.

We find that claims 1-6 and 15-20 are drawn to non-statutory subject matter as they encompass an abstract idea. The law in the area of patent-eligible subject matter for process claims has recently been clarified by the Supreme Court in *Bilski v. Kappos*, 130 S. Ct. 3218, No. 08-964, 2010 WL 2555192 (U.S. June 28, 2010). The Court held that the term “process” as used in 35 U.S.C. § 101, does not categorically exclude business methods. *Bilski*, 130 S. Ct. at 3228-3229.

The Court is unaware of any argument that the “ordinary, contemporary, common meaning,” *Diehr, supra*, at 182, 101 S.Ct. 1048, of “method” excludes business methods. Nor is it clear what a business method exception would sweep in and whether it would exclude technologies for conducting a business more efficiently.

Bilski, 130 S. Ct. at 3222.

“At the same time, some business method patents raise special problems in terms of vagueness and suspect validity.” *Bilski*, 130 S. Ct. at 3229. (*citing eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 397 (2006))(Kennedy, J., concurring).

In searching for a limiting principle, this Court's precedents on the unpatentability of abstract ideas provide useful tools. See *infra*, at 12-15. Indeed, if the Court of Appeals were to succeed in defining a narrower category or class of patent applications that claim to instruct how business should be conducted, and then rule that the category is unpatentable because, for instance, it represents an

attempt to patent abstract ideas, this conclusion might well be in accord with controlling precedent. *Bilski*, 130 S. Ct. at 3229 (2010).

Claims 1-6 and 15-20 are drawn to business methods. Taking claim 1 as representative, the broadest reasonable construction of the claimed process in light of the Specification as it would be interpreted by one of ordinary skill in the art is that it provides a series of instructions that do no more than acquire information; develop, characterize, and label preliminary findings; vote for a conclusion associated with each preliminary finding; and develop and label a plurality of final findings based upon the vote. The claim encompasses any use of the concept of acquiring information; developing, characterizing, and labeling preliminary findings; voting for a conclusion associated with each preliminary finding; and developing and labeling a plurality of final findings based upon the vote.

We now turn to the question of whether the claimed process subject matter is patent-eligible under 35 U.S.C. § 101. Various factors must be considered and weighed when analyzing claims as a whole before reaching a conclusion on patent subject matter eligibility.

The factors relevant in this case are the lack of an express or implied recitation in the claims to a particular machine or transformation and that the claims are a mere statement of a general concept. Claim 1 requires no transformation.

Claim 1 recites that the voting occurs electronically, which may imply the use of a machine. However, “*Flook* stands for the proposition that the prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant post-solution activity.’” *Bilski*, 130 S.

Ct. 3218, 3230 (quoting *Diamond v. Diehr*, 450 U.S. 175, 191-192 (1981)). The terms suggest at best a nominal use of a machine and impose no meaningful limits on the scope of the claim apart from describing a field in which to conduct the process. A field-of-use limitation is insufficient to render an otherwise patent-ineligible process patent eligible. See *Diehr*, 450 U.S. 175, 191 (1981). Cf. *SiFR Technology, Inc. v. International Trade Commission*, 601 F.2d 1319, 1333 (Fed. Cir. 2010):

In order for the addition of machine to impose a meaningful limit on the scope of the claim, it must play a significant part in permitting the claimed method to be performed, rather than function solely as an obvious mechanism for permitting a solution to be achieved more quickly, i.e., through the utilization of a computer for performing calculations.

We note that method claim 15, as compared to method claim 1, does not contain a recitation of “electronically.”

As we have reasonably broadly construed it, the subject matter of claim 1 is a series of instructions for acquiring information; developing characterizing, and labeling preliminary findings; voting for a conclusion associated with each preliminary finding; and developing and label a plurality of final findings based upon the vote. The vague instructions listed in the claim do no more than instruct how business should be conducted; that is to acquire information; develop, characterize, and label preliminary findings; vote for a conclusion associated with each preliminary finding; and develop and label a plurality of final findings based upon the vote. The claim covers any use of this concept. In the words of *Gottschalk v. Benson*, 409 U.S. 63, 72 (1972), the claimed process “would wholly pre-empt the [concept of acquiring information; developing characterizing, and labeling

preliminary findings; voting for a conclusion associated with each preliminary finding; and developing and label a plurality of final findings based upon the vote] and in practical effect would be a patent on the [concept] itself.”

For the foregoing reasons, based upon consideration of all the relevant factors with respect to claims 1-6 and 15-20 as a whole, claims 1-6 and 15-20 are held to claim an abstract idea and are therefore rejected as ineligible subject matter under 35 U.S. C § 101.

Since our reasoning in finding claims 1-6 and 15-20 directed to non-statutory subject matter under 35 U.S. C § 101 differs from that of the Examiner, we reverse the Examiner’s rejection and designate our reasoning above as a new ground of rejection.

The rejection of claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Wilkinson and Official Notice I-IV.

Claims 1-6 and 15-20

Claim 1 recites a method which includes steps of “characterizing and labeling each preliminary finding with an associated characterization selected from a group consisting of a strength and a weakness” and a step of “characterizing and labeling each final finding with an associated characterization selected from a group consisting of a strength and a weakness.” Initially, we note that the method of claim 1 requires an act of “characterizing” and not merely that the findings have a trait or quality. *See* Answer 15 (“As understood by the examiner, an associated characterization of something is viewed as an [inherent] trait or quality”).

In rejecting claim 1, the Examiner asserts that the principles shown in Table 3 of Wilkinson “are inherently characterized as strengths or weaknesses.” We note that the Examiner relies upon Table 3 to teach both the preliminary findings and the final findings. Answer 6 and 7. The Examiner then states: “However, examiner takes official notice that since each finding in the [Wilkinson] report is written in such a way so as to include an inherent characterization, i.e., “suggested reading were *useful* in accomplishing workshop goals” inherently conveys a strength, it would have been obvious to one of ordinary skill in the art to actually label the finding.”

The Appellant argues that the Examiner has not established the each finding (i.e., the principles of Table 3 prior to the survey responses) is inherently characterized as a strength or weakness. App. Br. 8-9 and Reply Br. 4-5.

We find that the Examiner has not established that the preliminary findings are inherently characterized as a strength or a weakness. While it may be possibly or probable to make such a characterization, the characterization is not necessarily present. “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted).

The Examiner has not established that in Wilkinson an act of characterizing each of the principles of Table 3 (e.g., “This Workshop has

been organized according to participatory principles”) as a strength or a weakness is inherently performed. While an act of characterizing the principles as a strength or weakness *could* be performed, this characterization does not *necessarily* happen in Wilkinson. We note that the Examiner provided no other findings or rationale for finding the steps at issue obvious.

Independent claim 15 also recites a method that includes similar steps and was rejected by the Examiner using the same rationale as above (*see* Answer 10-11). Accordingly, we find that the Examiner has failed to establish a *prima facie* showing of obviousness in rejecting claims 1 and 15. The Appellant has overcome the rejection of claims 1 and 15, and claims 2-6 and 16-20, dependent thereon, under 35 U.S.C. § 103(a) over Wilkinson and Official Notice I-IV.

Claims 7-14

Unlike claim 1, claim 7 recites an article instead of a method. Claim 7 recites a computer-readable storage medium having stored computer-readable program code portions that include “a second executable portion” and a “fourth executable portion” for performing the steps at issue above with regards to claim 1. To reject claim 7, the Examiner relies upon the same rationale used to reject claim 1. *See* Answer 9. For the same reasons as discussed above, we find that the Examiner has not establish the Wilkinson inherently teaches an article that has a structure as recited in claim 7. Accordingly, we find that the Examiner has failed to establish a *prima facie* showing of obviousness. The Appellant has overcome the rejection of claim 7, and claims 6-14, dependent thereon, under 35 U.S.C.

§ 103(a) over Wilkinson and Official Notice I-IV.

DECISION

The decision of the Examiner to reject claims 1-20 is reversed.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

Appeal 2009-009420
Application 09/848,519

REVERSED; 37 C.F.R. § 41.50(b)

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